

REMARKS

By this amendment, Applicants amend claims 1, 11, 21, 25 and 26, cancel claims 16, 17, 19, 20, and 23 without prejudice or disclaimer of the subject matter thereof, and add new claim 27. Upon entry of these amendments, claims 1-6, 8-12, 14, 15, 21, 22, and 24-27 will be pending in this application.

At the outset, Applicants note that the Examiner has not returned an initialed copy of a PTO Form 1449 that accompanied a Supplemental Information Disclosure Statement filed on April 8, 2004. Applicants therefore respectfully request that the Examiner return an initialed copy of the form indicating the Examiner's consideration of the documents listed therein.

In the Final Office Action,¹ the Examiner rejected claims 16, 17, 19, 20, 25, and 26 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants respectfully traverse this rejection. However, in an effort to expedite prosecution in this case, Applicants have canceled claims 16, 17, 19, and 20. Further, with regard to claims 25 and 26, Applicants have amended these claims to delete the term "a finite sequence." Accordingly, Applicants request the Examiner to withdraw the rejection under 35 U.S.C. § 112, second paragraph.

The Examiner rejected claims 1-6, 8-12, 14-17, 19, 21-26 under 35 U.S.C. § 103(a) as being unpatentable over Katou (U.S. Patent No. 6,006,161) in view of to Shah et al. (U.S. Patent No. 5,428,546). Applicants have canceled claims 16, 17, 19, 20, and 23, rendering the rejection with regard to these claims moot. With regard to

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

claims 1-6, 8-12, 14, 15, 21, 22, and 24-26, Applicants respectfully traverse the rejection for at least the following reasons.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Claim 1 recites a method of georeferencing a raster map including, among other things, "computing a georeferencing function that specifies a relationship between the pixel coordinates of the first map and the geographic coordinates of the second map." The asserted references do not disclose or suggest at least these features.

By contrast, Katou discloses a land vehicle electronic navigation system. For example, the navigation system is embedded in the dashboard of a vehicle. See col. 4, lines 35-36. The navigation system provides detection of the location of the vehicle and displays its location to an operator of the vehicle. This enables the vehicle's operator to "view and verify his or her vehicle's present location and acquire necessary information concerning a route along which the vehicle is to travel." See col. 4, lines 37-39. Katou, however, does not teach or suggest at least "computing a georeferencing function that

specifies a relationship between the pixel coordinates of the first map and the geographic coordinates of the second map,” as recited in claim 1.

Shah does not overcome the deficiencies of Katou. Shah discloses a method and system for “simultaneously displaying a raster map and vectorized street information. The system extracts information from a plurality of databases, including a mobile position database, a raster database, and a vector database. The database information is interrelated by common latitude and longitude information. A graphical user interface displays the information in a format easily understood to a dispatcher.” See Abstract. For example, “[v]ector utilities 632 match the latitude and longitude position information 634 to the latitude and longitude of street segment information 636 from the Vector Database 631.” See col. 5, lines 45-48. Shah therefore discloses retrieving information from a variety of sources or databases to relate the information. Therefore, Shah, like Katou, does not teach or suggest at least “computing a georeferencing function that specifies a relationship between the pixel coordinates of the first map and the geographic coordinates of the second map,” as recited in claim 1.

The Examiner has not established a *prima facie* case of obviousness because the Examiner has not shown that Katou and Shah, taken alone or in combination, disclose or suggest all of the features of claim 1. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection to claim 1. Based at least on their dependence upon claim 1, Applicants respectfully request the Examiner to withdraw the rejection of claims 2-6 and 8-10 as well.

Furthermore, for the reasons set forth above regarding claim 1, independent claim 11 is also allowable. Applicants have amended claim 11, although of different

scope from claim 1, to include similar recitations as those of claim 1. Accordingly, Katou in view of Shah fail to disclose each and every element of claim 11. Applicants therefore respectfully request the Examiner to withdraw the rejection of claim 11, as well as that of claims 12, 14, and 15 due to their dependence upon claim 11.

Claims 21, 22, and 24 depend from independent claims 1 and 11, and are allowable for at least the reasons discussed above in connection with claims 1 and 11. Applicants respectfully request the Examiner to allow claims 21, 22, and 24 at least due to their dependence.

Claim 25 recites a combination including, among other things, “computing, with each additional point-pair received after the first point-pair, a georeferencing function for the first map that expresses a mathematical relationship between pixel coordinates of an arbitrary point on the first map and corresponding geographic coordinates on the second map.” At least this element of claim 25 is neither disclosed nor suggested by the cited prior art for at least the same reasons discussed above in relation to independent claims 1 and 11. Claim 26 depends from claim 25. Accordingly, Applicants respectfully request the Examiner to allow claims 25 and 26.

New claim 27 depends from allowable claim 1, and therefore, is allowable at least due to its dependence. Accordingly, Applicants respectfully request that the Examiner allow new claim 27.

CONCLUSION


In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 

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